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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,382	11/15/2000	Clayton A. George	54680USA8B.008	4594

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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

9

DATE MAILED: 08/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/713,382

Applicant(s)

GEORGE ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 23 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The Examiner notes that most of the newly submitted dependent claims also find much more explicit express support from original claims 1-10, in addition to that pointed out by Applicants (Response, page 6, Section III). The Examiner would like to suggest Applicants amend the Specification, where necessary, by incorporating the necessary sections of cancelled dependent claims 2-10 (note, e.g., claim 6) into the Specification, so as to provide clear express support for the new claims 21-28.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Newly added claims 29 and 30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

For both claims 29 and 30, the Examiner finds that page 17, lines 15-29 does not provide either express or inherent support as pointed out by the Applicants (Response, page 6, Section III). It is also noted that this "new matter" based rejection is given for

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what are essentially impossible structures, i.e., in both claims a third layer is supposedly being bonded to a bulk layer whose first and second surfaces are already bonded to other layers.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 29-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 29-30, the layer structure describing the relation between the "bulk layer" and either the "glass substrate" (claim 29) or the "first substrate" (claim 30) appears incorrect. Specifically, in each claim, (I) (b) states the foam core is bonded to the second major surface of the bulk layer, and (I) (c) states an adhesive layer is bonded to the first major surface of the bulk layer. As such, it would appear impossible that the bulk layer is also able to be bonded to a third layer, as claimed in (II) of each claim.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Newly presented claims 21-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 6-8 of U.S. Patent No. 6316099 in view of EP 0392090.

For claims 21-25 and 28, US '099 shows all the features of the instant claimed invention, except the presence of a foam core layer. EP '090 teaches that a dam rubber for a car window having a spacer function, and the dam rubber comprises a laminate of foamed layers (Abstract). As such, it would have been obvious to modify US '099 to include a foam core layer, motivated by the desire to provide suitable adaptability to gap variations.

For claim 26-27, it is noted that the core layer is comprised of a polymer foam material (column 14, line 45 to column 15, line 20). It is believed that a polymer foam would inherently have a lower ultimate tensile strength than the bulk layer and the adhesive layer. Further, when the optional core layer is included in the article, <sup>obviously</sup> inherently it would require a tie layer between the core layer and the bulk layer, motivated by the desire to adhere the core layer to the article as an integral component.

### ***Response to Amendment***

9. The terminal disclaimer, filed on July 23, 2002, Paper No. 8, does not comply with 37 CFR 1.321(b) and/or (c) because the serial number of this application being

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disclaimed is missing or incorrect. More particularly, there is no assignee for 09/713382 on the record, and the terminal disclaimer fails to indicate that both 09/713382 and 08/941430 are owned by the same party. Therefore, the terminal disclaimer has not been accepted.

10. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being obvious over Johnson et al. (US 6284360) in view of Sekisui Chemical Co. (JP 10195393), substantially for the reasons set forth in sections 6 of Paper No. 5.

While it is true that a proper Terminal Disclaimer would overcome the last double patenting rejection as set forth in section 2 of Paper No. 5, it is noted that the Terminal Disclaimer does not eliminate the above grounds of rejection for claims 11-20, notwithstanding applicants comments to the contrary (Response, page 6, section II).

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

VSC

August 28, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900

1700

*Daniel Zinker*